

REMARKS

In view of the following remarks, the Examiner is respectfully requested to allow Claims 22-29, 32-35, and 37-39 the only claims pending and currently under examination in this application.

Claims 22, 34, 37, 38, and 39 have been amended. Support for the amendments may be found throughout the specification and claims as originally filed. For instance, support may be found at paragraphs 77, 79, and 81. Accordingly no new matter has been entered.

As no new matter has been entered by way of these amendments, their entry is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 22-29, 32-35, and 37-39 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Applicants respectfully disagree, however, in order to expedite prosecution and advance the case to issuance, the Applicants have amended the claims. In view of the amendments to the claims, this rejection has been obviated and may, therefore, be withdrawn.

Claim 39 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Applicants respectfully disagree, however, in order to expedite prosecution and advance the case to issuance, the Applicants have amended the claims. In view of the amendments to the claims, this rejection has been obviated and may, therefore, be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 22-29, 32-34, and 37-39 have been rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Kurdi in view of Mandell (U.S. Patent No. 3,335,088) and

further in view of Homan (U.S. Patent No. 4,347,336), Lee (U.S. Patent No. 6,124,407), or Wong (U.S. Patent No. 5,051,275).

The Office appears to be rejecting the claims based on a simple substitution of one known element for another to obtain predictable results. According to the M.P.E.P. § 2143, in order to establish a *prima facie* case of obviousness pursuant to this rational the Office must articulate the following: (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components; (2) a finding that the substituted components and their functions were known in the art; (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Claim 22, and the claims dependent there from, is directed to a method for forming a slider assembly. The method includes arranging a plurality of sliders each having a surface such that the surfaces are coplanar to each other, dispensing an organosilicon material encapsulant fluid in a manner effective to fill gaps or recesses between the sliders without contacting the coplanar slider surfaces, and subjecting the dispensed encapsulant fluid to a curing temperature from about 150° C to about 200° C, which is effective for the fluid to form a readily debondable solid encapsulant comprising an organosilicon material. Accordingly, an element of the rejected claims is a readily debondable solid encapsulant comprising an organosilicon material.

With respect to the present rejection, the Office acknowledges that Kurdi is deficient in that Kurdi does not teach a silicon-based debondable encapsulant that is cured at a temperature of about 150° C or more. The Office, therefore, relies partially on Mandell for this teaching. Specifically, the Office seeks to substitute the resin disclosed in Kurdi with the silicone encapsulant disclosed in Mandell. The Applicants respectfully disagree and contend that a *prima facie* case of obviousness has not been established because the Office has not established that the results of the proposed substitution would have been predictable.

Accordingly, a *prima facie* case of obviousness has not been established because the Office has not established that the results of the proposed substitution would have been predictable. Specifically, Kurdi is directed to preparing an bearing surface of a slider. For this purpose Kurdi employs a removable resin. See column 6, lines 42-43. Mandell, on the other hand, is directed to a method for the removal of a resin from a substrate. For this purpose Mandell employs hydrofluoric acid. In supporting this rejection, the Office asserts that Mandell stands for the proposition that a silicon elastomer, as disclosed in Mandell, is the functional equivalent of the removable resin disclosed in Kurdi.

The Applicants, however, disagree and contend that simply because one or more of an acrylic, epoxy, and silicon elastomer may be equivalents with respect to the fact that they may all be removed from the surface of a substrate when contacted with hydrofluoric acid, as disclosed in Mandell, does not mean that a silicone elastomer is the functional equivalent of an acrylic or epoxy resin as those resins are employed in Kurdi. Specifically, upon reading Mandell, one of skill in the art would not be led to expect that acrylic, epoxy, and silicon elastomers would function equally well as encapsulants, nor would one expect that they could be removed as easily without employing hydrofluoric acid to effectuate such removal.

For instance, one of skill in the art would not employ hydrofluoric acid, as disclosed in Mandell, to remove the resin from the surface of the slider disclosed in Kurdi. One would not do this for fear that the acid would degrade one or more of the components of the slider thereby damaging the slider and rendering it inoperable. Accordingly, if a silicone elastomer were substituted as the resin employed in Kurdi, one would have to employ a means other than hydrofluoric acid for removing that resin and because of this, it would be unpredictable if such other means would be effective in removing the silicone elastomer. In view of this, the Applicants contend that the Office has not established a *prima facie* case of obviousness because the Office has not established that the results of the proposed substitution would have been predictable. For this reason alone this rejection may be withdrawn.

Further, the above notwithstanding, the Applicants contend that this rejection rests on the assumption by the Office that both epoxy and silicon based encapsulants are recognized within

the art as being equivalents. To substantiate this assumption the Office erroneously attempts to rely upon Mandell. However, as described above, although Mandell may stand for the proposition that hydrofluoric acid is capable of removing both epoxy resins and silicon based encapsulants, Mandell does not stand for the proposition that epoxy resins and silicon based encapsulants are to any extent functional equivalents, as Mandell does not address the functionality of either element. In fact, as pointed out by the Applicants, during the Applicants' research into the field, they determined that cured epoxy materials, e.g., pure thermosetting epoxy resins, such as those disclosed in Kurdi, can be removed from sliders only with great difficulty and often with leaving significant material residue on the slider surfaces. See the Applicants' specification at paragraph 7. Thus, in this regard the resins disclosed in Kurdi are not in fact functional equivalents to the presently claimed organosilicon material encapsulants, and contrary to the assertion of the Office, it is not "well taken in the art of removable/debondable encapsulants that acrylic, epoxy, and silicon elastomer based encapsulants are functionally equivalent. Additionally, to the extent that the Office is taking Official Notice of the alleged equivalence of epoxy resins and organosilicon material encapsulants, the Applicants would like to draw the attention of the Office to *In re Ahlert*, wherein it was determined that it would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of *instant* and *unquestionable* demonstration as being well-known (emphasis added). See *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. For this reason alone this rejection may be withdrawn.

Furthermore, the Office additionally relies on Homan, Lee or Wong for their alleged disclosure of silicone elastomers as encapsulants that cure at 150° C. The Applicants, however, contend that the reliance of the Office on these references is unfounded. According to the Court in *In re Grasselli*, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The Applicants contend that with respect to the encapsulants disclosed in all of Homan, Lee or Wong, the cited references all teach away from the rejected claims because these cited references all teach a permanent "non-debondable" encapsulant. For instance, Homan discloses an encapsulant that is designed to impregnate an electrical coil and thereby act as an insulator

therefore. See column 6, lines 23-25. Lee discloses an encapsulant that is designed to protect electronic devices from the environment. See column 1, lines 19-22. Wong discloses an encapsulant designed for protecting electronic devices. See column 1, lines 6-9. Accordingly, each of the cited references is directed to a permanent, "non-debondable" encapsulant, and thus, to that extent, all of the cited references teach away from organosilicon material encapsulants that are debondable. For this reason alone this rejection may be withdrawn.

Additionally, an element of the claims as amended is an organosilicon material encapsulant. It is noted that Kurdi in view of Mandell is deficient in that it does not teach or suggest an organosilicon material encapsulant. As Homan, Lee and Wong was relied upon for their alleged disclosure of silicone elastomers as encapsulants that cure at 150° C, they fail to remedy the deficiencies of Kurdi in view of Mandell. As it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim, the Applicants contend that a *prima facie* case of obviousness has not been established because the Office has not set forth wherein the cited references all of the features of the claims as amended is taught or suggested. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). For this reason alone this rejection may be withdrawn.

Accordingly, in view of the above, a *prima facie* case of obviousness has not been established with respect to Claims 22-29, 32-34, and 37-39 and the Applicants respectfully request that this rejection be withdrawn.

Claim 35 has been rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Kurdi in view of Mandell and Lee or Wong and further in view of Joffre et al. (U.S. Patent No. 5,840,800) and Wong (U.S. Patent No. 4,564,562).

Claim 35 ultimately depends from Claim 22. Accordingly, the remarks set forth above with respect to Kurdi in view of Mandell and Lee or Wong apply with equal force to the rejection of Claim 35. Additionally, the Applicants contend that a *prima facie* case of obviousness has not been established because the Office has not set forth a reasoning as to how

Joffre stands for the proposition that metallic and amino based catalysts are functionally equivalent, nor has the Office set forth any reasoning whatsoever as to why or how one of ordinary skill in the art could have substituted the metallic catalyst of Lee or Wong for the amino based catalysts of Joffre and expected that the results of the substitution would have been predictable. Without these findings, a *prima facie* case of obviousness has not been established, and the Applicants, therefore, respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

Respectfully submitted,

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